IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Tarulis** Serial No.: **10/706,370**

Group Art Unit: **3781** Confirmation No.: **6383**

Filed: **November 12, 2003** Examiner: **Braden, Shawn M.**

For: **DRAWN WALL IRONED CAN FOR LIGHT COLORED FRUITS**

Mail Stop Appeal Brief-Patents
Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF IN RESPONSE TO THE EXAMINER'S ANSWER

Sir:

This paper is in response to the Examiner's Answer dated March 11, 2008, in relation to the above-identified application.

REMARKS/ARGUMENTS

This Reply Brief is submitted in response to the Examiner's Answer dated March 11, 2008.

1. Response to the Examiner's Arguments

The Examiner contends that "there is nothing in the claim defining thickness before or after drawing." The Appellant notes that both claims 1 and 22 are both drawn to *completed* cans, not to processes for making them. As such they inherently refer to the thickness *after* drawing.

The Examiner also states that the term "pounds per base box, is typically used for stock materials, i.e. (before material is drawn) it is not used as a measurement after a material is drawn." The Appellant respectfully submits that the Examiner is merely asserting this position as if it were fact. Clearly the measurement type can be used both prior to and after the drawing process. This can be evidenced by the usage by the Appellant, who is a member of the industry, in describing the thickness of the can material in pounds per base box both pre-drawing and post drawing of the can. See *The Specification,* page 4, lines 3-21 and page 5, lines 4-15.

The Examiner further states that the "appellant has not disclosed a thickness of tin per base box before drawings." The Appellant respectfully disagrees and points to page 4, lines 3-21 of the Specification, which sets forth the pounds per base box prior to the drawn wall ironing process.

The Examiner further contends that "it would be well within the skill of one with ordinary skill in the art to start out with 1 or 1.25 or 1.50 lb per basebox thus guaranteeing a final thickness of at least .20 lb per bb." The Appellant again notes that U.S. Patent No. 4,095,544 to Peters et al. (hereinafter "Peters") does not discuss the finished product and furthermore does not discuss starting out with "1 or 1.25 or 1.50 lb per basebox." Additionally, Peters teaches a different process that involves a heat treatment, which clearly has an effect on the finished

product. See *Peters*, FIGS. 13 and 15 and Col. 6, lines 35-65. What the effect is on the finished product in terms of thickness is not discussed or taught in Peters. Therefore, the Examiner is not only speculating about a starting thickness but is also speculating about the effects that the process taught in Peters has on the end results. The Appellant respectfully submits that using such speculation as grounds for rejection is impermissible.

The Examiner notes that the Appellant pointed out that the finished sidewall 19 has a steel substrate 20, a layer 26 and a layer 28 on top of the substrate 29 and on top of those layers, a layer 22 and a layer 24 of tin." See *Peters,* FIGS. 13-15. The Appellant, also noted that Peters mentions that as a result of the process discussed in Peters the layers 26 and 28 are fractured, thus suggesting that the coating is both breached and non-intact. See *Peters,* Col. 6, lines 35-41. It is the Appellant's contention that because of these facts Peters does not meet the limitations of claim 1 which requires, *inter alia*, that "said sidewall further compris[es] no additional protective coating on said unbreached, intact second coating."

The Examiner addresses this issue by stating that he "views elements (26), and (28) to be part of the substrate (20), then a first coating comprising tin (24) on an outer surface thereof and a second unbreached, intact coating (22) comprising tin on an inner surface thereof." See *The Examiner's Answer,* page 5. The Appellant respectfully submits that the Examiner cannot simply change what is disclosed in Peters in order to fit his needs. Substrate 20 is made of steel, while layers 26 and 28 are made out of tin-iron alloys. See *Peters,* Col. 2, lines 36-53. Layer 26 and layer 28 are clearly not part of the substrate 20. The Examiner cannot simply gloss over these facts and try to force Peters to read on the limitations of the claims.

The Examiner additionally submits that "the Examiner's response in the advisory action was for clarification as a result of appellant's argument and not a new grounds of rejections or an attempt to shift the burden." The Appellant respectfully disagrees.

2. Conclusion

The Appellant has made an earnest effort to address the arguments presented by the Examiner in this proceeding. Removal of the grounds of rejection presented by the Office is

again requested. If the Examiner feels that a telephone interview would expedite prosecution of this patent application, he is respectfully invited to telephone the undersigned at 215-599-0600.

Respectfully submitted,

/Tod A. Kupstas/

Tod A. Kupstas
Registration No. 54,917

Date: April 14, 2008

KNOBLE YOSHIDA & DUNLEAVY, LLC
Eight Penn Center- Suite 1350
1628 John F. Kennedy Boulevard
Philadelphia, PA 19103
(215) 599-0600 Main
(215) 599-0601 Fax
takupstas@patentwise.com